

## **REMARKS**

With this response, claims 86, 90, 93, 94, 97, and 98 are pending. Claims 86 and 90 have been amended without prejudice. Claims 89, 91-92, and 99-110 were withdrawn by the Examiner as allegedly being directed to a non-elected invention. Claims 87, 88, 95, and 96 were previously canceled without prejudice or disclaimer in Applicants' Response dated September 14, 2007. Applicants reserve the right to prosecute the non-elected subject matter in divisional applications. Support for the foregoing amendment can be found, for example, in the claims as originally filed and in the specification at page 119, lines 4-16, and at page 127, lines 13-22. No new matter is added.

### **I. Election/Restrictions**

Applicants acknowledge the Examiner's withdrawal of claims 89, 91-92, and 99-110 as allegedly being directed to a non-elected invention. Applicants reserve the right to file divisional applications containing the withdrawn claims upon the finding of an allowable subject matter.

### **II. Claim Objections**

Claim 90 has been objected to as being drawn to compounds in the context of a product-by-process format. The Examiner asserts that "product-by-process claim language is reserved for situations where the compound cannot be claimed in a definite manner...The instant application does not fall into this category, as the compounds are definite." Final Action at page 3. Applicants respectfully traverse the claim objections.

A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. *See In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is made, so long as it is clear that the claim is directed to the product and not the process. *See* MPEP § 2173.05(p). Applicant respectfully submit that, in claim 90, they are claiming oil in a transgenic seed and not the process of making the oil in the transgenic seed.

At the outset, at least claim 86 is not in a product-by-process format, and as such, this objection should not apply to dependent claim 90, as indicated by the Examiner. As such, reconsideration and withdrawal of this objection are respectfully requested.

### **III. Rejection Under 35 U.S.C. § 101**

Claims 86, 90, 93-94, and 97 were rejected under 35 U.S.C. § 101, as directed to non-statutory subject matter. According to the Examiner, “(w)hile brassicastanol (may) not be a naturally occurring phytostanol, stigmastanol which the claims read is a commonly occurring plant stanol.” Final Action at page 4. Applicants respectfully traverse the rejection. The structure of the claimed stigmastanol, as described in the present specification, has not been found to occur in nature, and thus the claimed oil containing this compound is directed to statutory subject matter. See claim 86 and claims dependent thereon; and the specification at page 119, lines 4-16, page 127, lines 13-22. However, Applicants submit that this rejection is rendered moot by the claim amendments which make more clear the structure of the claimed stigmastanol. As such, withdrawal of this rejection is respectfully requested.

### **IV. Rejection of Claims Under 35 U.S.C. § 102**

Claims 86, 90, 93-94, and 97 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fernholz *et al.* In rejecting the claims, the Examiner asserts that Fernholz *et al.* teaches an oil containing brassicasterol as one of its components which “reads on the instant oil, which only requires that one of the group consisting of brassicastanol, or its ester, stigmastanol, or its ester.” Final Action at page 4. Applicants respectfully traverse the rejection.

Whatever else Fernholz *et al.* teach or suggest, they do not teach or suggest an oil comprising a compound selected from the group consisting of brassicastanol, at least one brassicastanol ester, stigmastanol, or at least one stigmastanol ester, and a mixture thereof as disclosed in the present specification. See Specification at page 119, lines 4-16, and page 127, lines 13-22. As described in the specification, phytosterols such as brassicastanol made commercially through hydrogenation of oils do not make 22-dihydro-brassicastanol, in which both the C-5 and C-22 double bonds are reduced. *Id.* Similarly, stigmasterol is hydrogenated by a plant to sitostanol, in which both the C-5 and C-22 double bonds are reduced. *Id.* The

Examiner has not shown where Fernholz *et al.* describe a double bond at position C5 or C22 for either brassicastanol or stigmastanol as claimed. The brassicastanol and stigmastanol listed by Fernholz *et al.* are produced by hydrogenation outside of plants. See Fernholz *et al.* at page 143, first column. The Examiner has not provided any evidence to overcome the teaching in the specification that the listed compounds are not the compounds recited in the claims.

For the foregoing reasons, Applicants respectfully assert that Fernholz *et al.* do not anticipate brassicastanol, stigmastanol, or their esters recited in the claims, and request withdrawal of this rejection. However, Applicants submit that the rejection of claims 86, 90, 93-94, and 97 under 35 U.S.C. § 102(b) is rendered moot by the claim amendments which make more clear the structure of the claimed brassicastanol and stigmastanol. As such, withdrawal of this rejection is respectfully requested.

## CONCLUSION

In view of the above, each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding objection and rejections of the claims, and to pass this application to issue. The Examiner is encouraged to contact the undersigned at (202) 942-5186 should any additional information be necessary for allowance.

Respectfully submitted,

/Kristan L. Lansbery/

David R. Marsh (Reg. No. 41,408)

Kristan L. Lansbery (Reg. No. 53,183)

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ARNOLD & PORTER LLP  
555 12<sup>th</sup> Street, N.W.  
Washington, D.C. 20004  
(202) 942-5000 telephone  
(202) 942-5999 facsimile